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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/649,495

08/27/2003

Wen-Lian Wu

CN01622

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7590

05/02/2006

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,495

Applicant(s)

WU ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 9, 11, 13, 15, 16, 19-23, 25, 27, 29-32, 34, 36 and 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8, 10, 12, 14, 17, 18, 24, 26, 33, 35 and 37 is/are allowed.
- 6) ☒ Claim(s) 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-39 are pending in the application.

Election/Restrictions

1. Applicant's election with traverse of Group II in the reply filed on February 24, 2006 is acknowledged. The traversal is on the ground(s) that it is inappropriate to restrict the invention to a single compound when there is a linking generic claim encompassing the scope of all the compounds, pharmaceutical compositions comprising them and methods of treatment using them. This is not found persuasive because there is no generic claim encompassing the scope of all of the compounds, compositions and method of use. Compounds of formula I do not encompass the compounds of formula II and visa versa. The applicants also stated that they believe that Groups I-IV would not cause an undue burden to the Examiner to examine them together. This is not found persuasive because a benzo[g]benzotriazolo[5,4-d][1]benzazepine a compound within formula (I) and benzo[g]benzothiazolo[6,7-d][1]benzazepin-2-one, a compound within formula (II) are clearly structurally dissimilar compounds.

(1) Note MPEP 2173.05(h) "where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression. Therefore, what should be considered for patentable distinctness is the compound as a whole. Would a whole compound where formula (II) is benzo[g]benzothiazolo[6,7-d][1]benzazepin-2-

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one, be patentably distinct from a whole compound where formula (I) is benzo[g]benzotriazolo[5,4-d][1]benzazepine? If a reference for one would not be a reference for the other, then restriction is considered proper. Community of properties is not enough to keep a benzo[g]benzothiazolo[6,7-d][1]benzazepin-2-one compound in the same Markush claim, where the Markush expression is applied only to a portion of a chemical compound. It is the compound as a whole formula (II) is benzo[g]benzothiazolo[6,7-d][1]benzazepin-2-one, imidazo[4,5-g][3]benzazepine-2-thione, benzimidazo[5,4-d]benzo[g][1]benzazepin-2-one, etc., that must be considered for patentable distinctness.

Thus, separate searches in the literature would be required. However, should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

(2) The degree of burden on the examiner is high. The class/subclass search on the elected invention of formula (II) would be as follows: class 514, subclass 215 and class 540, subclass 578, which involved 538 US patents. The classes and subclass mentioned above represent only the degree of burden within the U.S. Patent Classification System this does not include the search required in the prior art of journal articles and foreign patents.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-4, 9, 11, 13, 15, 16, 19-23, 25, 27, 29-32, 34, 36 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 24, 2006.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

The applicants have stated that the specification is attached hereto in the Oath/Declaration filed May 11, 2004, which is not so.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

a) Claim 28 is vague and indefinite in that it is not known what is meant by "wherein the disorder". It is not known to what disorder this refers.


Allowable Subject Matter

5. Claims 5-8, 10, 12, 14, 17, 18, 24, 26, 33, 35, 37 and 39 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions and method of use of the compounds of formula II as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brenda L. Coleman
Primary Examiner Art Unit 1624
April 28, 2006